

Application No.: 10/726,618
Attorney Docket No. 52493.000310

REMARKS

The Office Action has been received and carefully considered. Claims 1-18 are pending in the present patent application. In this response, claims 1 and 17 are amended. Claim 17 is amended to further define Applicant's claimed invention.

No new matter has been introduced by this Amendment. Support for the Amendments may be found on pages 8-10 of the application and in the previously presented claims, for example. Entry of the amendments to the claims is respectfully requested.

Reconsideration of the current rejections in the present application is respectfully requested based on the following remarks.

A. The 35 U.S.C. 101 Rejection

On page 2 of the Office Action, claims 1-4 and 17-18 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

In response to the comments in the Office Action, claims 1 and 17 are hereby amended to satisfy the requirements of 35 U.S.C. 101. Claim 1 is amended to recite "the method implemented on a tangibly embodied computer readable medium in the form of executable code for causing a processor to use medication and medical condition information in automated insurance underwriting". The "processor" is further recited in the body of claim 1. Claim 17 is amended in a similar manner.

Applicant submits that such amendments to claims 1 and 17 overcome the 35 U.S.C. 101 rejection. Applicant would welcome further suggestions from the Examiner regarding amendments to even further satisfy the requirements of 35 U.S.C. 101.

In view of the foregoing, it is respectfully requested that the aforementioned non-statutory subject matter rejection of claims 1 and 17 be withdrawn.

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B. The 35 U.S.C. 102 Rejection

On page 3 of the Office Action, claims 1, 3-5, 7-9, 11-13, 15, and 16 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Application Publication No. 2002/0087364 to Lerner *et al.* ("Lerner"). This rejection is hereby respectfully traversed.

Under 35 U.S.C. § 102, the Patent Office bears the burden of presenting at least a prima facie case of anticipation. In re King, 801 F.2d 1324, 1326 (Fed. Cir. 1986). Anticipation requires that a prior art reference disclose, either expressly or under the principles of inherency, **each and every element of the claimed invention**. Celeritas Tech., Ltd., v. Rockwell Int'l Corp., 150 F.3d 1354, 1361 (Fed. Cir. 1998). "In addition, the prior art reference must be enabling." Akzo N.V. v. U.S. International Trade Commission, 808 F.2d 1471, 1479 (Fed. Cir. 1986), cert. denied, 482 U.S. 909 (1987). That is, the prior art reference must sufficiently describe the claimed invention so as to have placed the public in possession of it. In re Donohue, 766 F.2d 531, 533 (Fed. Cir. 1985). Such possession is effected only if one of ordinary skill in the art could have combined the disclosure in the prior art reference with his/her own knowledge to make the claimed invention.

Regarding claim 1, the Examiner maintains the assertion that Lerner discloses the claimed invention. Specifically, the Examiner asserts that Lerner discloses "identifying medication information provided by an applicant," as presently claimed. Applicant respectfully disagrees. In contrast, Applicant previously argued that Lerner merely discloses a server system prompts the user for responses to "current medical conditions and lifestyle (e.g., occupation, participation in dangerous recreational activities, use of tobacco or other substances (e.g., drugs, cigars, cigarettes, pipes, etc.)." *See, e.g.,* paragraph [0022]. Although, Lerner mentions the server system prompts the user for response to use of drugs, the drugs of Lerner is not the

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"medication information," as presently claimed. The drugs of Lerner is directed to tobacco, cigars, cigarettes, and pipes. In contrast, the "medication information," as presently claimed is directed, in accordance with one embodiment of the invention, to medication taken by the Applicant and the medication information may include, for example, "the names of the medications, the amount taken per dosage, the frequency of dosage, the time period for which each medication is taken, etc." See, e.g., Specification paragraph [0026], i.e., as one illustrative embodiment. Therefore, Applicant respectfully submits that Lerner at best discloses identifying use of tobacco or tobacco related substances by an applicant and fails to disclose, "identifying medication information provided by an applicant," as presently claimed.

In response to Applicant's assertions, in the "Response to Arguments" on page 16, the Office Action asserts:

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the **features upon which applicant relies** (i.e., "the names of the medications, the amount taken per dosage, the frequency of dosage, the time period for which each medication is taken, etc." See, e.g., Specification paragraph [0026].) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Also in response to applicant's argument that that Lerner at best discloses identifying use of tobacco or tobacco related substances by an applicant and fails to disclose, "identifying medication information provided by an applicant"; a recitation of **the intended use** of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing **the intended use**, then it meets the claim. Examiner asserts the invention disclosed in Lerner includes responding to "current medical conditions and lifestyles", and this disclosed invention is **capable of "identifying the medication information provided by an applicant,"**

(emphasis added)

Applicant traverses such assertions.

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Applicant's arguments illustratively referred to Applicant's specification and embodiments therein. However, Applicant's arguments indeed relied upon the claim language, as recited in claim 1. Applicant submits that the claimed "identifying medication information", as fairly interpreted, is not taught by Lerner as alleged in the Office Action. That is, Applicant submits that the relied upon "the server system prompts the user for responses to policy specific questions (e.g., age, sex, state of residence, medical and family history (e.g., history of cancer, heart disease, etc.), current medical condition and lifestyle)" simply does not fairly teach the recited manipulation of "medication information".

Further, Applicant submits that the assertions in the Office Action regarding "intended use" are misplaced. Claim 1 clearly sets forth the positive recitation that the method includes a particular step, i.e., claim 1 recites "identifying medication information provided by an applicant". Such claimed feature does not constitute "intended use," but rather a claimed, positively recited feature that must be taught by the applied art, in order to support the rejection under 35 U.S.C. 102. Applicant submits that, based on the assertions in the Office Action, Lerner fails to teach such feature, as recited in claim 1.

Applicant notes in general the various assertions in the Office Action alleging that claimed features constitute "intended use." The Examiner is requested to reconsider what is asserted as constituting "intended use." A positively recited recitation, set forth in a claim, cannot be appropriately discounted as "intended use," i.e., so as to allow the diminished patentable weight accorded "intended use," as alluded to in the Office Action.

In Applicant's prior response, Applicant further argued as to Lerner's deficiencies. Applicant asserted:

Also, the Examiner asserts that Lerner discloses "assessing a consistency between the medication information and the medical condition information, as presently claimed."

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In particular, the Examiner alleges that a server system of Lerner quantitatively assesses and analyzes the information to determine an eligibility score or value with respect to the insurability issues of interest as disclosing "assessing a consistency between the medication information and the medical condition information," as presently claimed. Applicant respectfully disagrees. Applicant submits that Lerner discloses the server system employs an algorithm based on insurer underwriting criteria to evaluate the medical information retrieved from databases 8 and the information provided by the potential customer and produce the underwriting score or value. *See, e.g.,* paragraph [0024]. Moreover, Lerner discloses a total risk factor or eligibility score is calculated by adding the individual assessment values assigned to the potential customer after review of the medical and application information. *See, e.g.,* paragraph [0024]. Nowhere does Lerner disclose that the algorithm used by the server system "assessing a consistency between the medication information and the medical condition information," as presently claimed. Furthermore, Lerner provides example of underwriting criteria may assign points based on medical test results or other information. By way of example, low blood pressure may be assigned one point, moderate blood pressure may be assigned three points and high blood pressure may be assigned five points. *See, e.g.,* paragraph [0024]. Therefore, Applicant respectfully submits that Lerner merely discloses a underwriting score and fails to disclose "assessing a consistency between the medication information and the medical condition information," as presently claimed.

In the present Office Action, the Examiner responded to Applicant's arguments. In particular, on page 18, the Office Action asserts:

Applicant also argues that Lerner does not anticipate "assessing a consistency between the medication information and the medical condition information". In response to applicant's argument, a recitation of the **intended use** of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Examiner asserts, as the Applicant has conceded, that the invention disclosed in **Lerner employs an algorithm to evaluate medical criteria**. The Examiner takes the position that this limitation of Lerner is **fully capable** of "assessing a consistency between the medication information and the medical condition information".

(emphasis added)

In response, Applicant submits that the Office Action's reliance on "intended use" is again misplaced. Indeed, the Office Action appears to be inappropriately discounting various features of Applicant's claimed invention based on a misplaced reliance on "intended use." The

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claimed feature of "assessing a consistency between the medication information and the medical condition information" cannot appropriately be interpreted as intended use.

Further, the assertions that allegedly support the rejection are deficient on other grounds. The claimed feature of "assessing a consistency between the medication information and the medical condition information" should be interpreted fairly and appropriately. Applicant submits that such feature, under a reasonable and appropriate interpretation, requires a comparison, of some nature, to be drawn. That is, "assessing a consistency" in a fundamental manner requires that the medication information and the medical condition information, i.e., two pieces of information, are compared in some manner.

Lerner (as well as the assertions in the Office Action) reflect a fundamental difference from such claimed features. That is, an algorithm to evaluate medical criteria, reflects that criteria is input, processed, and an output is generated based on such processing. Such differs from the claimed feature in which two pieces of information, from the applicant, are compared, i.e., Applicant submits that even broadly interpreted the claimed feature requires some type of comparison, albeit indirect, to be performed between the medication information and the medical condition information. Relatedly, Applicant submits that the assertions in the Office Action that "Lerner employs an algorithm to evaluate medical criteria" and the Examiner takes the position that this limitation of Lerner is fully capable of "assessing a consistency between the medication information and the medical condition information" is not supportable. The relied processing of Lerner is fundamentally different (and not capable) of performing the claimed processing.

In Applicant's prior response, Applicant asserted that Lerner merely discloses making an insurance underwriting decision based on the total risk factor or eligibility score and fails to disclose "making at least one insurance underwriting decision based on the **consistency** between

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the medical information and the medical condition information," as presently claimed. In response, the Office Action asserts:

Applicant further argues that Lerner does not anticipate "making at least one insurance underwriting decision based on the consistency between the medication information and the medical condition information". Applicant's arguments do not comply with 37 CFR 1.111 (c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections. Examiner asserts, as the Applicant has conceded, that the invention disclosed in Lerner **discloses making a decision on underwriting insurance**. Thus the Examiner takes the position this limitation, disclosed in Lerner, is not **patently distinct** from applicant's limitation of "making at least one insurance underwriting decision based on the consistency between the medical information and the medical condition information."

(emphasis added)

On a fundamental level, Applicant traverses the assertion that such teachings of Lerner and the claimed feature are not patentably distinct. Applicant submits that based on a fair interpretation of the teachings of Lerner vis-à-vis the claimed feature, Lerner fails to teach the claimed feature under 35 U.S.C. 102. Accordingly, Applicant respectfully submits that Applicant's arguments do comply with 37 CFR 1.111 (c) and clearly point out the patentable novelty which the claims present in view of the state of the art disclosed by the references cited, i.e., in that the deficiencies of the applied art are apparent on their face.

Further, Applicant submits that Lerner fails to teach assessing a "consistency". Accordingly, Lerner even more clearly fails to teach the subsequent manipulation of such quantity, i.e., Lerner fails to teach "making at least one insurance underwriting decision based on the **consistency** between the medication information and the medical condition information", as recited in claim 1. (Emphasis added)

Regarding claims 3 and 4, these claims are dependent upon independent claim 1. Thus, since independent claim 1 should be allowable as discussed above, claims 3 and 4 should also be

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allowable at least by virtue of their dependency on independent claim 1. Moreover, these claims recite additional features which are not disclosed, or even suggested, by the cited references taken either alone or in combination.

Regarding claims 5, 9, and 13, these claims recite subject matter related to claim 1. Thus, at least some of the arguments set forth above with respect to claim 1 are equally applicable to claims 5, 9, and 13. Accordingly, it is respectfully submitted that claims 5, 9, and 13 are allowable over Lerner for the same reasons as set forth above with respect to claim 1.

Regarding claims 7, 8, 11, 12, 15, and 16, these claims are dependent upon independent claims 5, 9, and 13. Thus, since independent claims 5, 9, and 13 should be allowable as discussed above, claims 7, 8, 11, 12, 15, and 16 should also be allowable at least by virtue of their dependency on independent claims 5, 9, and 13. Moreover, these claims recite additional features which are not disclosed, or even suggested, by the cited references taken either alone or in combination.

In view of the foregoing, it is respectfully requested that the aforementioned anticipation rejection of claims 1, 3-5, 7-9, 11-13, 15, and 16 be withdrawn.

C. THE 35 U.S.C. 103 REJECTION

On page 6 of the Office Action, claims 2, 6, 10, 14, 17, and 18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0087364 to Lerner *et al.* ("Lerner") in view of U.S. Patent Application Publication No. 2001/0032099 to Joao ("Joao"). This rejection is hereby respectfully traversed.

Under 35 U.S.C. § 103, the Patent Office bears the burden of establishing a prima facie case of obviousness. *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988). There are four separate factual inquiries to consider in making an obviousness determination: (1) the scope and content

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of the prior art; (2) the level of ordinary skill in the field of the invention; (3) the differences between the claimed invention and the prior art; and (4) the existence of any objective evidence, or "secondary considerations," of non-obviousness. Graham v. John Deere Co., 383 U.S. 1, 17-18 (1966); see also KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727 (2007). An "expansive and flexible approach" should be applied when determining obviousness based on a combination of prior art references. KSR, 127 S. Ct. at 1739. However, a claimed invention combining multiple known elements is not rendered obvious simply because each element was known independently in the prior art. Id. at 1741. Rather, there must still be some "reason that would have prompted" a person of ordinary skill in the art to combine the elements in the specific way that he or she did. Id.; In re Ikon Health & Fitness, Inc., 496 F.3d 1374, 1380 (Fed. Cir. 2007). Also, modification of a prior art reference may be obvious only if there exists a reason that would have prompted a person of ordinary skill to make the change. KSR, 127 S. Ct. at 1740-41.

Regarding claim 17, this claim recites subject matter related to claim 1. Thus, the arguments set forth above with respect to claim 1 are equally applicable to claim 17. Accordingly, it is respectfully submitted that claim 17 is allowable over Lerner in view of Joao for the same reasons as set forth above with respect to claim 1.

It is respectfully submitted that the aforementioned obviousness rejection of claims 2, 6, 10, 14, and 18 is moot in view of the deficiencies of the primary reference (i.e., Lerner) as discussed above with respect to independent claims 1, 5, 9, 13, and 17. That is, claims 2, 6, 10, 14, and 18 are dependent upon independent claims 1, 5, 9, 13, and 17 and thus inherently incorporate all of the limitations of independent claims 1, 5, 9, 13, and 17. Also, the secondary reference (i.e., Joao) fails to disclose, or even suggest, the deficiencies of the primary reference as discussed above with respect to independent claims 1, 5, 9, 13, and 17. Indeed, the Examiner

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does not even assert such. Thus, the combination of the secondary reference with the primary reference also fails to disclose, or even suggest, the deficiencies of the primary reference as discussed above with respect to independent claims 1, 5, 9, 13, and 17. Accordingly, claims 2, 6, 10, 14, and 18 should be allowable over the combination of the secondary reference with the primary reference at least by virtue of their dependency. Moreover, claims 2, 6, 10, 14, and 18 recite additional features which are not disclosed, or even suggested, by the cited references taken either alone or in combination.

In view of the foregoing, it is respectfully requested that the aforementioned obviousness rejection under 35 U.S.C. 103 be withdrawn.

D. Conclusion

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

To the extent necessary, a petition for an extension of time under 37 CFR § 1.136 is hereby made.

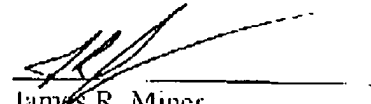
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Respectfully submitted,

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